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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/735,394	12/12/2003	Peter Euteneuer	LWEP:121US	1710

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EXAMINER

PRITCHETT, JOSHUA L

ART UNIT	PAPER NUMBER
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2872

DATE MAILED: 03/06/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/735,394

Applicant(s)

EUTENEUER ET AL.

Examiner

Joshua L. Pritchett

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 1-19-06.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-48 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-48 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 12 December 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
 - 2) ☐ Certified copies of the priority documents have been received in Application No. _____.
 - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

This action is in response to Request for Continued Examination and Amendment filed January 19, 2006. Claims 1 and 2 have been amended as requested by the applicant.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-5 and 8-18 are rejected under 35 U.S.C. 102(e) as being anticipated by Takahama (US 2002/0131165).

Regarding claim 1, Takahama discloses an inverted microscope having a U-shaped microscope housing (1) on one limb whereof is provided a horizontal changing surface (51 or 7; which has edges that move in the horizontal direction) for optical and mechanical adaptation of a module (Figs. 8 and 7), wherein the module (54 and 201) comprising a horizontally protruding base (Fig. 8) having on the one hand a binocular tube (64) placed thereon and on the other hand a

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photo tube (201) with a photo device (202) placed thereon (Fig. 8) and wherein the binocular tube and the photo tube extend above the horizontal changing surface (Fig. 8).

Regarding claim 2, Takahama discloses the module is embodied as a one-piece combination module (Fig. 8) and has on its underside a module changing apparatus (53) that is adapted to be received by the horizontal changing apparatus (Fig. 8). Takahama shows that the horizontal changing apparatus moves (from Fig. 7 to Fig. 8) such that the module changing apparatus must be inserted when the Takahama invention is in the state as shown in Fig. 8 but removed when the invention is in the state shown in Fig. 7. The claim limitation says nothing about how the apparatus is “adapted” therefore Takahama satisfies the claimed limitations.

Regarding claims 3 and 8, Takahama disclose the vertical optical axis (coming off deflector 55) of the observation beam bundle, extending in the one limb penetrates through a first optical deflection element (56) after entering the base unit (Fig. 8) then passes through first tube lens (63) arranged in the binocular tube, while the photo beam deflected at the optical deflection element (Fig. 8), after passage through a second tube lens (204) and after deflection by a second optical deflection element (206) enters the phototube with attached photo device (Fig. 8).

Regarding claims 4 and 9-11, Takahama discloses the optical deflection element can be selectably brought into or out of the working position (Figs. 7 and 8). Fig. 7 shows that there is no element 56, while Fig. 8 shows an element 56 to operate as the optical deflection element.

Regarding claims 5 and 12-18, Takahama discloses an infinity beam exists in the region of the changing surface of the module changing apparatus (Fig. 8).

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The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 6, 7 and 19-48 are rejected under 35 U.S.C. 103(a) as being unpatentable over Takahama (US 2002/0131165).

Takahama teaches the invention as claimed but lacks reference to different corrections for the photo tube and the binocular tube. It is extremely well known in the art to use periplan correction for flat field eyepieces and HC correction for magnetic recording media. Official Notice is taken. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have the Takahama invention include the corrections as known in the art for the purpose of producing a clear image to both the viewer and the photo device.

Response to Arguments

Applicant's arguments filed January 19, 2006 have been fully considered but they are not persuasive.

Applicant argues that the Takahama reference cannot optically and mechanically adjust the module. Applicant further argues that Takahama can adapt either optically or mechanically

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but not both. If applicant intends to state that Takahama can provide for either optical or mechanical adaptation depending on the location of the mirror, then because the mirror position can change as seen in Figs. 7 and 8 the Takahama reference is capable of both optical and mechanical adaptation. Applicant states that the mirror 51 cannot optically adjust the module in the horizontal position, therefore if the mirror is not in the horizontal position the mirror 51 would be able to optically adjust the module. Applicant further states the mirror 51 cannot mechanically adjust the module because it does not change in the physical orientation of the module to the housing. As shown in the change from Fig. 7 to Fig. 8, the rotational movement of the mirror 51 or 7 is capable of accommodating for mechanical adaptations of the module.

Applicant argues that the term horizontal means parallel to the base of the microscope housing. This limitation is not part of the claim.

Applicant argues that claim 1 is directed to adaptation of the module not the mirror itself. As shown in the changes from Fig. 7 to Fig. 8 the mirrors 51 or 7 allow for the adaptation of the module and therefore satisfy the claimed limitations.

Applicant argues prior art fails to teach or suggest a change in the orientation of the module in a new physical position. The change is shown in the difference between Fig. 7 and Fig. 8.

Conclusion

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joshua L. Pritchett whose telephone number is 571-272-2318.

The examiner can normally be reached on Monday - Friday 7:00 - 3:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Drew A. Dunn can be reached on 571-272-2312. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JLP *JP*



DREW A. DUNN
SUPERVISORY PATENT EXAMINER